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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,174	04/19/2004	Masayuki Yoshida	H 50019	2416
423	7590	03/06/2006	EXAMINER	
HENKEL CORPORATION THE TRIAD, SUITE 200 2200 RENAISSANCE BLVD. GULPH MILLS, PA 19406			TUROCZY, DAVID P	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/827,174	Applicant(s) YOSHIDA ET AL.	
	Examiner David Turocy	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/23/2006 has been entered.

Response to Amendment

2. Applicant's amendments, filed 1/23/2006, have been fully considered and reviewed by the examiner. The examiner notes the amendments to claims 1, 13, and 21, the cancellation of claim 5, and the addition of new claim 22. Claims 1-4 and 6-22 are pending.

Response to Arguments

3. Applicant's arguments filed 1/23/2006 have been fully considered but they are not persuasive.

The applicant has argued against the examiners position of optimization of cleaning and lubricating times during a process because such are result effective variables. The applicants argue the coating thickness is a result of various parameters, not a single parameter, and uses Figure 5 of Illig et al as support for such a position.

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While the examiner agrees the coating thickness appears to clearly be a result of various parameters, Illig clearly discloses the wire drawing speed is a result effective variable and it remains the examiners position that it is within the skill of one ordinary in the art to determine the optimum wire drawing speed and therefore optimize the time spent in the lubricant, etc. In addition, it would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as processing time through routine experimentation in the absence of a showing of criticality. *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

The applicant argues Imai does not teach of a continuous inline system. The examiner notes, Page 12, lines 25-28 of Imai, they discloses the lubricant composition can be used during cold plastic working, such as wire drawing and pipe drawing, which are known in the art as continuous processes, where the steps as taught by Imai would all be utilized in a continuous inline system.

The applicant has argues against the Imai reference stating they teach of cleaning and a lubrication times larger then the claimed times and there is no teaching in the Imai reference to shorten either times. While the examiner agrees the times as taught by Imai reference are longer then the claimed times, the examiner maintains the position that such times are known result effective variables as discussed in the office action dated 12/21/2004. It is the examiner position that it is well within the skill of one of ordinary skill in the art to optimize the cleaning and lubrication time depending on the desired properties associated with such cleaning and lubrication times.

The applicant has argued against the Hagita reference stating they use a zinc phosphate conversion coating during the continuous in-line drawing process and a lubricant with a reactive soap. The applicant has argued Hagita does not properly teach of lubrication times as taught by the applicant's claims. While the examiner agrees Hagita teaches of a zinc phosphate coating, Imai teaches such an undercoat is not requires using the lubricant composition. Therefore taking the references collectively, the combination of Imai in view of Hagita clearly suggests to one of ordinary skill in the art to provide a continuous inline system absent a phosphating coating. The examiner is only utilizing Hagita to show the process of applying a lubricant is known in the art to be a cause effective variable depending on various factors, where one factor may be the presence of a the phosphating treatment, and therefore optimization of such lubrication times is well within the skill of one of ordinary skill in the art.

The applicant has argued against the Imai reference stating they teach of a lubricant where a synthetic resin is used as the main component. However the examiner respectfully disagrees. While synthetic resin may be a component of the lubricant as taught by Imai, the claim does not limit the lubricant bath to only the components listed. The applicant has argued the claim limitation of claim 21 requires "consisting essentially of" and therefore cannot include a resin component as taught by Imai. The examiner respectfully disagrees and notes MPEP 2111.03. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA

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1976) (emphasis in original). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. It is the examiners position that the presence of polyvinyl alcohol (PVA), see Tables 1-3 (quantity of 1 weight percent), does not materially effect the basic and novel characteristics of the claimed invention because as shown in paragraph 0027, inclusion of polyvinyl alcohol in the process is within the scope of the invention. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964)

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 22 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was

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- not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner cannot locate support in the specification for the added limitation of a solid matter concentration of the lubricating coating ranges from 5 to 15 weight percent. It does not appear as though the specification provides support for a range including all weight percents with a lower limit of 5 and an upper limit of 15.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 3-4, 8, 11, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/64544 by Imai et al ("Imai").

Claims 1, 3-4, 8, and 11 are rejected for the same reasons as set forth in the office action dated 12/21/2004 and 7/22/2005 and for the reasons in section 3 above.

Claim 21: Imai teaches of a applying a lubricant composition for plastic working of metals by first cleaning the metal, then contacting the metals with an aqueous lubricious film formation treating solution which contains at least one kind of inorganic salt and at least one kind of lubricant, and finally dried after application of lubricant (abstract, page 12, lines 31-36, Page 13 lines 6-8). Imai discloses the lubricant composition can be used as the lubricant that is employed during the cold plastic working e.g., wire drawing, pipe drawing, forging (Page 12, lines 25-28). Imai discloses an inorganic salt with a weight percent of 3%-8% and a lubricant weight percent of 3-5%, which is a weight ratio of lubricant to salt within the range of 0.375-1.67 (Table 2). Imai teaches of at least one inorganic salt selected from the group consisting of phosphate, sulfate, borate, silicate, molybdate and tungstate (Page 8, lines 4-6). Imai teaches of at least one kind of lubricant selected from the group consisting of metal soap, wax, polytetrafluoroethylene, molybdenum disulfate and graphite (Page 9, lines 4-19). See for example Table 3, example number 20. The reasons set forth in section 3 above apply here for the phrase "consisting essentially of".

Claim 22: Imai discloses a solid matter ratio within the range as claimed, see for example Table 3, example 20, with a solid matter concentration is 7 weight percent.

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10. Claims 1-4, 6, 8-11, 13-14, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/64544 by Imai et al ("Imai") in view of US Patent 4688411 by Hagita et al ("Hagita").

Claims 1-4, 6, 8-11, 13-14, and 16-20 are rejected for the same reasons as set forth in the office action date 12/21/2004 and 7/22/2005 and for the reasons in section 3 above.

11. Claims 7,12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/64544 by Imai et al ("Imai") taken in view of US Patent 4688411 by Hagita et al ("Hagita") alone or when further taken in view of US Patent 5282377 by Illig et al ("Illig").

Claims 7,12, and 15 are rejected for the same reasons as set forth in the office action date 12/21/2004 and 7/22/2005 and for the reasons in section 3 above.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Turocy whose telephone number is (571) 272-2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Turocy
AU 1762



TIMOTHY MEEKS
SUPERVISORY PATENT EXAMINER